

ESTTA Tracking number: **ESTTA519956**

Filing date: **02/05/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85362134
Applicant	Vault Bioventures, Inc.
Applied for Mark	VAULT BIOVENTURES
Correspondence Address	KATHLEEN A. PASULKA PROCOPIO CORY HARGREAVES & SAVITCH LLP 525 B ST, SUITE 2200 SAN DIEGO, CA 92101-4474 UNITED STATES docketing@procopio.com
Submission	Appeal Brief
Attachments	TTAB_Appeal_Brief_VAULT_BIOVENTURES.pdf ( 7 pages )(38104 bytes )
Filer's Name	Kathleen A. Pasulka
Filer's e-mail	docketing@procopio.com, glj@procopio.com
Signature	/kap/
Date	02/05/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

、  
**In re Service Mark Application of:** )  
 )  
**Vault Bioventures, Inc.** ) **MARK: VAULT BIOVENTURES**  
 )  
**Serial No. 85/362,134** ) **Classes: 35, 38, 42**  
 )  
**Filed: July 1, 2011** )  
\_\_\_\_\_ )

**APPLICANT'S BRIEF ON APPEAL**

Commissioner for Trademarks  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Commissioner:

Applicant Vault Bioventures, Inc. ("Applicant") submits its Brief On Appeal from the refusal by the Trademark Examining Attorney ("Examining Attorney") to allow Applicant's application for VAULT BIOVENTURES, for services described as Class 35: "Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and biotechnology companies;" Class 38: "Assistance, advisory services and consultancy with regard to communications in the medical field for biopharmaceutical and biotechnology companies;" and Class 42: "Assistance, advisory services and consultancy

services with regard to clinical research and product development for biopharmaceutical and biotechnology companies” (sometimes referred to as “Applicant’s Mark”), to register.

### **FACTS**

1. Applicant filed its application for VAULT BIOVENTURES on July 1, 2011 in Class 35 for “Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, clinical and market research and development, branding, project management, portfolio management and medical communications in the field of biopharmaceutical and biotechnology companies” under Serial No. 85/362,134.

2. The Examining Attorney issued an Office Action on October 21, 2011, requiring an amendment of the services in Class 35 to: “Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and biotechnology companies”; and requiring the addition of Class 38 for: “Assistance, advisory services and consultancy with regard to communications in the medical field for biopharmaceutical and biotechnology companies” and Class 42 for: “Assistance, advisory services and consultancy with regard to clinical research and product development for biopharmaceutical and biotechnology companies.” The Examiner also required the disclaimer of the word BIOVENTURE, as well as citing likelihood of confusion with marks (1) VAULT COMMUNICATIONS, INC., Registration No. 4030759 for Class 35: “public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means”, which issued on September 27, 2011 to Registrant Vault Communications, Inc.; (2) VAULT COMMUNICATIONS, INC. and Design, Registration No.

4030758 for Class 35: “Public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communications means,” which issued on September 27, 2011 to Registrant, Vault Communications, Inc.; and (3) THE VAULT, Registration No. 3864144 for Class 35: “Advertising, marketing and promotion services,” which issued on October 19, 2010 to Registrant, The Vault NYC, LLC.

3. Applicant responded to the first Office Action on April 23, 2012, by providing information that confusion would not exist because the marks, services and commercial impressions differed, the relevant purchasers are sophisticated, and VAULT BIOVENTURES is limited to the biopharmaceutical and biotechnology fields. Applicant agreed to disclaim the word BIOVENTURES, and amended its services in Class 35 and adding Classes 38 and 42, all as requested by the Examiner.

4. On May 15, 2012, the Examiner issued a Final Office Action against Class 35 only citing likelihood of confusion against U.S. Registration Nos. 4030759, 4030758 and 3864144.

5. The Applicant filed a Request for Reconsideration on November 15, 2012 addressing the reasons why Applicant believes confusion will not exist with the cited registrations.

6. On December 6, 2012, the Examining Attorney denied the Request for Reconsideration filed by Applicant.

### **ISSUE TO BE DECIDED**

The issue to be decided is whether a likelihood of confusion exists between Applicant’s use of VAULT BIOVENTURES in Class 35 for: Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio

management for biopharmaceutical and biotechnology companies” **and** Registrants’ use of the marks:

- (a) VAULT COMMUNICATIONS, INC., Registration No. 4030759 for Class 35: “public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communication means”, which issued on September 27, 2011 to Registrant Vault Communications, Inc.;
- (b) VAULT COMMUNICATIONS, INC. and Design, Registration No. 4030758 for Class 35: “Public relations, marketing and advertising services, namely, promoting and marketing the goods and services of others through public communications means,” which issued on September 27, 2011 to Registrant, Vault Communications, Inc.; and
- (c) THE VAULT, Registration No. 3864144 for Class 35: “Advertising, marketing and promotion services,” which issued on October 19, 2010 to Registrant, The Vault NYC, LLC.

## **ARGUMENT**

### **I.     Introduction**

Applicant's services are: Class 35- Assistance, advisory services and consultancy with regard to business analysis, business development, business operations, marketing, product commercialization, market research, branding, business project management and portfolio management for biopharmaceutical and biotechnology companies; Class 38- Assistance, advisory services and consultancy with regard to communications in the medical field for biopharmaceutical and biotechnology companies; Class 42- Assistance, advisory services and consultancy services with regard to clinical research and product development for biopharmaceutical and biotechnology companies .

The Examining Attorney 's rejection of Applicant's application is based upon the belief that Applicant's mark: VAULT BIOVENTURES is likely to be confused with Registration Nos. 4030759, 4030758 and 3864144, all in Class 35.

Registration No. 4030759 is VAULT COMMUNICATIONS, INC. for marketing and advertising services (Reg. '759). Registration No. 4030758 is for VAULT COMMUNICATIONS, INC. with a stylized "V", also for marketing and advertising services (Reg. '758). Both Reg. '759 and '758 are owned by the same company, Vault Communications, Inc.

Registration 3864144 is for THE VAULT and is owned by a different company, The Vault NYC. This Registration and is also for advertising, marketing and promotion services (Reg. '144).

As Applicant has previously asserted, Applicant does not agree that confusion is likely to occur in view of the above listed Registrations / cited marks, primarily on the basis that the marks differ, the services differ, the commercial impressions differ and the relevant purchasers are sophisticated.

Applicant's mark is VAULT BIOVENTURES, for the services listed above, is limited to the biopharmaceutical and biotechnology fields. The biopharmaceutical and biotechnology fields are distinct communities with a limited number of sophisticated players.

II. Confusion is Not likely to Occur:

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

A. Comparing the Marks:

Although Applicant has been required to disclaim the word "BIOVENTURES", this word still carries significance within the mark and teaches the public that the services relate to biotechnology and related fields. On a scale from one to ten, with one being the most descriptive, BIOVENTURES would definitely be much closer to a one or a two. This word does carry enough significance apart from its apparent meaning to be capable of helping to differentiate Applicant's mark from the cited marks in a manner closer to that of a suggestive mark. This is especially the case in a two word mark.

B. Comparing the Commercial Impressions:

The differences between the cited marks and Applicant's mark are significant enough to create entirely different commercial impressions. THE VAULT Registration (Reg.'144) brings to mind a locked container. Applicant's mark, while it contains the word VAULT, does not convey such an impression. Rather, Applicant's mark brings to mind something along the lines of a biology based venture that is bound for success. VAULT COMMUNICATIONS, INC. appears as a company name because of the word "INC" and the word "COMMUNICATIONS" creates a different commercial impression to the word "BIOVENTURES".

C. Comparing the Services:

Applicant's services are advisory and consultancy business services directed to the biotech and pharma industries. The services for the cited marks are marketing and advertising services generally. These services differ. As stated above, the biotech and pharma fields are very distinct and unique. The advisory and consulting services offered by Applicant are specifically directed to these industries and do not consist of the general marketing and advising services offered under the cited marks. There is little chance that any consumer would be confused.

D. Sophistication of Purchasers:

Applicant's services as well as those offered by the owners of the cited Registrations differ greatly from inexpensive goods offered off store shelves. In addition, the services offered by Applicant and the owners of the cited Registrations are services that would need to be tailored to each particular customer and these services would be inexpensive. These factors weigh against the likelihood that confusion will take place. In addition, the biotech and pharma industries are an especially sophisticated community and the services of Applicant are specifically directed to their needs alone.

Based upon the foregoing, Applicant respectfully requests that its appeal be granted so that its application for VAULT BIOVENTURES, including Class 35, can proceed to registration.

Respectfully submitted,

Procopio, Cory, Hargreaves & Savitch LLP

Dated: February 5, 2013

By:  \_\_\_\_\_

Kathleen A. Pasulka  
Attorneys for Applicant  
Vault Bioventures, Inc.

Procopio Cory Hargreaves & Savitch LLP  
525 B Street, Suite 2200  
San Diego, CA 92101  
Telephone: (619) 525-3827  
Facsimile: (619) 235-0398  
docketing@procopio.com  
Docket No.: 118199-1